REMARKS

Claims 1-24 are pending in this Application.

Claims 1-24 have been rejected.

Claims 19-24 have been amended as shown above.

Claims 1-24 remain pending in this Application.

Reconsideration of Claims 1-24, as amended, is respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 101

On Pages 2-3 the August 24, 2005 Office Action rejected Claims 19-24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In response, the Applicant has amended Claims 19-24 to recite a "recorded video product" that comprises a plurality of data packets that are embodied in a computer readable storage medium. The Applicant respectfully submits that Claims 19-24, as amended, now recite patentable subject matter. Accordingly, the Applicant respectfully requests withdrawal of the § 101 rejections.

II. REJECTIONS UNDER 35 U.S.C. § 103

On Pages 3-10 the August 24, 2005 Office Action finally rejected Claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,734,862 to Kulas (hereafter "*Kulas*") in view of U.S. Patent No. 6,438,319 to Inoue et al. (hereafter "*Inoue*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to

make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

Regarding Claim 1, the August 24, 2005 Office Action asserts that *Kulas* discloses a "first data packet" having "location information identifying a storage address of a second data packet" at column 13, lines 17-19. (*August 24, 2005 Office Action, Page 3, Lines 16-20*). However, the cited portion of *Kulas* describes a buffer that contains slots, where each slot is capable of storing "a frame of data along with any associated information." (*Kulas, Col. 12, Line 59 – Col. 13, Line 1*). The cited portion of *Kulas* specifically recites that each slot in a "linked list of slots" includes a "pointer to the next slot in the list." (*Kulas, Col. 13, Lines 13-16*).

This portion of *Kulas* simply recites that each slot in a buffer includes a pointer to another slot in the buffer. This portion of *Kulas* lacks any mention of a "first data packet" that identifies the storage address of a "second data packet" as recited in Claim 1. In particular, this portion of *Kulas* lacks any mention of a "first data packet" that includes "header information," where the header information includes "location information identifying a storage address of a second data packet" as recited in Claim 1.

Moreover, Claim 1 recites that the "first data packet" is associated with a "first Intra frame" and that the "second data packet" is associated with a "second Intra frame." The Office Action fails to establish that the "frame" in one slot of the buffer of *Kulas* points to another "frame" in another slot of the buffer, where both "frames" are "Intra frames." In fact, the Office Action cannot make this showing.

The buffer stores consecutive frames from a "data path." (*Kulas, Col. 13, Lines 26-65*). *Kulas* states: "Routine 240 of FIG. 11 is entered at step 242. Routine 240 is called often enough to obtain each frame from the data path without missing frames as they are read off of the CD-ROM disc at a more or less constant rate." (Emphasis added) (*Kulas, Col. 13, Lines 26-29*). This shows that the *Kulas* device stores consecutive frames without missing any frames.

Kulas also expressly states that intra frames generally represent "one of every 12 frames in a sequence." (*Kulas, Col. 16, Lines 28-31*). Based on this, the Office Action cannot establish that two consecutive frames in the buffer of *Kulas* are "Intra frames," where a "first data packet" associated with the "first Intra frame" includes location information identifying the storage address of a "second data packet" associated with a "second Intra frame" as recited in Claim 1.

The Office Action also acknowledges that *Kulas* fails to disclose a device that "modifies header information" in a first data packet to include location information identifying a storage address of a second data packet. (*August 24, 2005 Office Action, Page 3, Lines 20-22*). The Office Action then asserts that *Inoue* discloses these elements of Claim 1 and that it would be obvious to combine *Kulas* and *Inoue*. (*August 24, 2005 Office Action, Page 3, Line 22 to Page 4, Line 4*).

The August 24, 2005 Office Action cites one portion of *Inoue* as disclosing these elements of Claim 1. (*Inoue, Col. 5, Lines 43-48*). However, the cited portion of *Inoue* simply recites that a "copyright field" in the header of a data packet may be modified to prevent the contents of the data packet from being copied more than an allowable number of times. (*Inoue, Col. 5, Lines 40-48*). This portion of *Inoue* contains absolutely no mention of modifying

the header of a data packet to include "location information" identifying the "storage location" of another packet as recited in Claim 1.

For these reasons, the August 24, 2005 Office Action fails to establish that the proposed *Kulas-Inoue* combination discloses, teaches, or suggests all elements of Claim 1.

In the August 24, 2005 Office Action, the Examiner asserted that "the slots of Kulas are equivalent to packets (see Newton's Telecom Dictionary, defining a packet as a "generic term for a bundle of data.)" (*August 24, 2005 Office Action, Page 2, Lines 12-14*). The Applicant respectfully traverses this assertion of the Examiner.

The Examiner did not quote all of the definition of the term "packet" as set forth in Newton's Telecom Dictionary. The full definition reads: 1. Generic term for a bundle of data, usually in binary form, organized in a specific way for transmission. (Emphasis added). The term "packet" does not generally refer to any "bundle of data" but rather to a "bundle of data" that is organized in a specific way for transmission. The term "packet" has a definite and accepted meaning in the telecommunications industry.

As previously mentioned, the cited portion of *Kulas* describes a buffer that contains slots, where each slot is capable of storing "a frame of data along with any associated information." The accepted definition of the term "packet" (data organized in a specific way for transmission) makes it clear that the term "packet" is not equivalent to a slot in a buffer as described by *Kulas*.

In the August 24, 2005 Office Action, the Examiner also asserted that "The frequency of Intra Frames cited by applicant in Kulas, column 16, lines 28-21, is dependent on the coding rate of the video (Kulas, column 16, lines 25-29), and intra frames may occur more frequently, or be

consecutive, at a slower coding rate. (*August 24, 2005 Office Action, Page 2, Lines 14-17*). The Applicant respectfully traverses the assertion of the Examiner that a slower coding rate will cause the intra frames to be consecutive. Because the *Kulas* system records all consecutive frames (i.e., does not miss any frames), a slower coding rate will not affect the identity of the intra frames. The intra frames will be consecutive only if they were consecutive to begin with.

Lastly, the Examiner stated that "Further, Kulas discloses storing location information, while Innoue discloses modifying headers, so the combination of the two renders the claims obvious." (*August 24, 2005 Office Action, Page 2, Lines 17-18*). The Applicant respectfully traverses these assertions of the Examiner. No motivation for combining the references is recited in this portion of the Examiner's comments.

For the reasons previously set forth, the Applicant respectfully traverses that all of the limitations of Claim 1 are met by *Kulas* except for the limitation of modifying header information in a first data packet to include location information identifying a storage address of a second data packet. The Applicant has already identified and discussed the deficiencies of the *Kulas* reference. These deficiencies are not corrected or supplied by any elements within the *Inoue* reference.

The cited portion of the *Inoue* reference refers to the concept of reciting that a "copyright field" in the header of a data packet may be modified to prevent the contents of the data packet from being copied more than an allowable number of times. (*Inoue, Col. 5, Lines 40-48*). This portion of *Inoue* contains absolutely no mention of modifying the header of a data packet to include "location information" identifying the "storage location" of another packet as recited

in Claim 1.

Furthermore, the supposed motivation set forth in the August 24, 2005 Office Action to "reduce access time to the stored media" is very general and does not specifically suggest combining the teachings of the *Kulas* reference with the teachings of the *Inoue* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire to obtain "reduced access time" is too general and vague to provide the legally requisite motivation to modify a reference or to combine reference teachings.

The Applicants respectfully submit that one skilled in the art would not attempt to combine the apparatus and method of *Kulas* with the apparatus and method of *Inoue*. The Applicants submit that a combination of the *Kulas* apparatus and the *Inoue* apparatus would be unworkable. For this reason there would be no suggestion or motivation to combine the teachings of the *Kulas* reference with the teachings of the *Inoue* reference.

Even if the *Kulas* reference could somehow be combined with the *Inoue* reference, the combination would not teach, suggest, or even hint at the Applicants' invention as set forth in Claim 1. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. In the present case, the *Kulas* reference and the *Inoue* reference in combination would not teach

or suggest all the claim limitations of the Applicants' invention. Therefore, the Applicants respectfully submit that the rejection of Claim 1 under 35 U.S.C. § 103(a) has been overcome.

For the same reasons set forth above with respect to Claim 1, the August 24, 2005 Office Action fails to establish that the proposed *Kulas-Inoue* combination discloses, teaches, or suggests analogous elements of Claims 7, 13, and 19. As a result, the August 24, 2005 Office Action has not established a *prima facie* case of obviousness against Claims 1, 7, 13, and 19 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of Claims 1-24, as amended.

III. CONCLUSION

The Applicant respectfully asserts that Claims 1-24, as amended, in this Application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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